

REMARKS

The Examiner is thanked for the clarity and conciseness of the Office Action, and for the citation of references, which have been studied with interest and care.

This Response is in response to the Office Action mailed May 27, 2003. In the Office Action, claims 3-6, 9-13 and 17-57 stand rejected. Applicant has amended independent claims 3, 9, and 17 to clarify the claims. Reconsideration in light of the amendments and the remarks made herein is respectfully requested.

Applicant respectfully submits that the claims are now in condition for allowance. If the Examiner believes a teleconference would be useful in the prosecution of this case, the Examiner is invited to contact the Applicant's attorney.

I. REJECTION UNDER 35 U.S.C. § 112

Claims 3-6, 9-13, and 17-57 were rejected in the Office Action under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Particularly, the Office Action set forth that it did not believe that the claim limitations "the first agent automatically gathers information from the target computer without the user's authorization" was not sufficiently supported within the specification. Applicant respectfully disagrees. However, in order to expedite prosecution of the case, Applicant has removed these limitations. Accordingly, Applicant respectfully requests that this ground for rejection be removed.

II. REJECTION UNDER 35 U.S.C. § 103

In the Office Action, claims 3-6, 9-13, and 17-57 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,279,112 B1 issued to O'Toole, Jr., et al. (O'Toole) in view of U.S. Patent No. 5,796,952 issued to Davis, et al. (Davis).

In regards to obviousness, as aptly stated by the Federal Circuit in *In re Kotzab*, 55 U.S.P.Q.2D (BNA) 1313, 1316-1317 (Fed. Cir. 2000):

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant...*Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.* (Emphasis added).

Particularly, the Office Action rejects amended independent claims 3, 9 and 17 as being allegedly obvious over O'Toole. Applicant respectfully submits that the Office Action is impermissibly using O'Toole to render obvious Applicant's invention, as defined by amended independent claims 3, 9 and 17, when O'Toole does not teach Applicant's claim limitations, and in fact *teaches away* from Applicant's claim limitations. Particularly, Applicant respectfully submits that the Office Action is misconstruing the “smart digital offer object” of O'Toole, and is impermissibly equating it with the “first agent” of Applicant's amended independent claims.

Applicant's amended independent claims 3, 9, and 17, include limitations related to a user rule page containing information obtained automatically from the target computer *by a first agent, wherein the first agent has a triggering program to filter information and to determine whether the information is relevant to the user rule page.*

Applicant's amended independent claims 3, 9, and 17 recite the use of an "agent," as is typically used in communication network applications, wherein the "agent" is a program that performs information gathering and/or processing tasks in the background. Background processes are typically defined as processes operating in the background that cannot accept interactive input from a user, but can access data stored on a disk and write data to the video display, etc. Attached hereto as Exhibit A are definitions for the terms "agent" and "background", from the Webopedia dictionary, which is an authoritative source for computer terms accessible from the Internet. Further, this definition of the term "agent" corresponds to the description of the agent, and the use of the agent, as disclosed in Applicant's specification.

In fact, Applicant respectfully submits that O'Toole teaches the opposite of an agent and *teaches away* from Applicant's amended independent claims 3, 9, and 17. In contrast to Applicant's claims, O'Toole uses an interactive smart digital offer object to allow the user to be interactively asked whether the user wishes to reveal certain user information and to further ask the user if the user wishes to accept an offer of a product or service, which the user can then interactively accept or decline. The interactive smart digital offer object is not an agent as recited in all of Applicant's amended independent claims, and in fact *teaches away* from Applicant's claimed invention.

As stated in the section of the O'Toole patent cited by the Office Action, O'Toole teaches:

The client computer fetches a document of web-based information from the offer-providing server that contains a smart digital offer object (step 118)...The client computer activates the smart digital offer object (step 120), and the smart digital offer object attempts to observe the parameters of the execution environment at the client machine, including the presence of coupons, and possibly other information such as a purchasing history recorded on the client computer....If the smart digital offer object attempts to observe the purchasing history or certain other user-specific information, the client computer asks the user whether the user wishes to reveal the information (step 122). The user indicates whether release of the

information is authorized (step 124), and the smart digital offer object then examines the coupon (including the coupon's authenticator), digital receipts (including authenticators) and other user-specific information authorized to be revealed by the user, and presents to the user an offer of a product or service (step 126)...When the user accepts the offer (step 128) the client computer sends a message to the offer-providing server indicating that the user has accepted the offer, or sends the message to an intermediary server that is trusted by the client computer to maintain the confidentiality of user-specific information and is trusted by the offer-providing server to verify the terms on which the offer was accepted (step 130)...The offer-providing server then fulfills the offer by causing the offered product or service to be provided to the user (step 134). (O'Toole, column 7, line 24 through column 8, line 21) (Emphasis Added).

Thus, O'Toole teaches an interactive smart digital offer object to allow the user to be interactively asked whether the user wishes to reveal certain user information and further to ask the user if the user wishes to accept an offer of a product or service, which the user can then interactively accept or decline. O'Toole quite clearly does not teach an "agent", as in Applicant's amended independent claims 3, 9, and 17, in which *a user rule page contains information obtained automatically from the target computer by a first agent, wherein the first agent has a triggering program to filter information and to determine whether the information is relevant to the user rule page*. In fact, O'Toole teaches away from utilizing an agent as in Applicant's claimed invention. As stated in the MPEP, "[i]t is improper to combine references where the references teach away from their combination." MPEP § 2145 (emphasis added). Accordingly, O'Toole cannot be used as a reference for obviousness and independent claims 3, 9, and 17 should be allowable.

Applicant would like to point out that, as stated in MPEP § 2111.01, the patentee is his/her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well-known definition. In O'Toole, the patentee defined a smart digital offer object, not an agent. The interactive smart digital offer object performs interactive functions such as asking whether the user wishes to reveal certain user information and further asks the user if the user wishes to accept an

offer of a product or service, which the user can then interactively accept or decline.

The smart digital offer object of O'Toole is quite clearly not an agent.

Thus, O'Toole does not teach, suggest, or render obvious Applicant's amended independent claims 3, 9, and 17, in which a user rule page contains information obtained automatically from the target computer *by a first agent, wherein the first agent has a triggering program to filter information and to determine whether the information is relevant to the user rule page*; and in fact teaches away from Applicant's amended independent claims 3, 9, and 17. Furthermore, O'Toole neither alone, nor in combination with Davis, teaches, suggests or renders obvious these claims limitation in combination with Applicant's other claims limitations, such as, *a rulebook to provide a rule based on the user rule page, the rule controlling the content to be transmitted from a database to the target computer, the rule stored in form of a condition-action pair, a condition in the condition-action pair being a hardware characteristic of the target computer, etc.*

Applicant respectfully submits that the limitations of independent claims 3, 9, and 17, as amended, are not taught, suggested, or rendered obvious by O'Toole alone, or in combination with Davis, and that, in fact, O'Toole teaches away from Applicant's amended claims limitations.

Accordingly, Applicant respectfully requests that the rejections of independent claims 3, 9, and 17 be withdrawn, and that these independent claims be allowed. Further, Applicant respectfully submits that the dependent claims are allowable because they are dependent upon allowable base claims, respectively.

CONCLUSION

In view of the remarks made above, it is respectfully submitted that pending claims 3-6, 9-13, and 17-57 define the subject invention over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: July 21, 2003

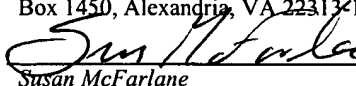


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Susan McFarlane

7/21/03
Date